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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/019.287

01/02/2002

Yasuyuki Kawahara

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08/01/2006

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,287

Applicant(s)

KAWAHARA ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11, 19-30 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8, 10, 11, 19-26, 28-30, 34-39, 41-51, 53-59, 61-71, 73-81 and 83-88 is/are rejected.
- 7) ☒ Claim(s) 9, 27, 40, 52, 60, 72 and 82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Final Rejection

The Status of Claims :

Claims 6-11 ,19-30, and 34-88 are pending.

Claims 6-8, 10-11 ,19-26, 28-30, 34-39, 41-51, 53-59, 61-71, 73-81, and 83-88 have been rejected.

Claims 9, 27, 40, 52, 60, 72, and 82 have been objected.

Claim Rejections - 35 USC § 112

1. Applicants' argument filed 5/25/06 have been fully considered but they are not persuasive.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 6-8, 10-11, 19-26,28-30, 34-39, 41-43, 44-51,53-59, 61-63, 64-71,73-75, 76-81, and 83-88 under 35 U.S.C. 112, first paragraph, has been maintained with a reason of record on 3/01/06.

Applicants' Argument

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a. In response to the examiner's remark of an unpredictable aspect of the catalysts in the art of organic chemistry, no experimentation is necessary to practice the invention as claimed; if the reaction is carried out using the recited "sulfur-free and phosphorous-free catalyst" in the preparation of an ester, the adjustment of the reaction conditions would be common practice to persons in the art and would not even be considered "experimentation", much less "undue experimentation." Therefore, reconsideration of the rejection is requested.

With respect to the applicants' argument, the Examiner has noted applicants' argument. However, on the contrary to applicants' argument, according to T.P.Hilditch, the author of the "Catalytic Processes in Applied Chemistry" (see pages Xiii-XV, 1929), there is a definitive reason for an unpredictable aspect of the catalysts in the art of organic chemistry. T.P.Hilditch expressly teaches that any catalyst would not work for any kind of the reaction process; for example, the specific catalysts such as mineral acids, acetic anhydride, sulfuric acid, calcium chloride, and etc can be used for the esterification; on the other hand, this same kind of catalyst will not apply to the other types of the reaction process in the followings: the chlorination of organic compounds, the oxidation of organic compounds, the process for rubber accelerators, the hydrogenation or the dehydrogenation processes, ammonia synthesis, ammonia oxidation, sulfuric acid manufacture, and etc. (see pages Xiii-XV). From this, it follows that applicants' assertion of common adjustment of the reaction conditions would not work for this case.

Furthermore, the specification of the claimed invention does support the very idea of the unpredictable aspect of the catalysts by disclosing the following specific, workable catalyst for the esterification, not all kind of the catalyst known in the art: tetra(C₃-C₈ alkyl)titanate, titanium oxide, titanium hydroxide, sodium alkoxide of 1 to 4 carbon atoms, sodium hydroxide, C₃-C₁₂ fatty acid tin salt, tin oxide, tin hydroxide, zinc oxide, zinc hydroxide, lead oxide, lead hydroxide, aluminium oxide and aluminum hydroxide. Moreover, applicants' specification provide only three exemplified catalysts, tin hydroxide, tin oxide, and tetraisopropyl titanate in the examples. These can not be the representative of all the known catalysts or any catalyst known in the art. However, the claims are directed to any sulfur-free and phosphorous-free catalyst. Moreover, the case law advocates that the catalyst compositions represent an unpredictable aspect in the art of organic chemistry. See *Exparte Sizto*, 9 USPQ2d 2081 (Bd. Of App. And Inter. March 1988). Thus, from evidence presented in the above, the specification herein has failed to provide sufficient working examples to support the use of various catalysts. Therefore, applicants' arguments are still irrelevant to the issue of the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mylo R. Or
7/27/06